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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/804,465

03/19/2004

Michael Willoughby

7235/6

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03/24/2008

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EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/804,465 | <b>Applicant(s)</b><br>WILLOUGHBY, MICHAEL |  |
|                              | <b>Examiner</b><br>ADAM LEVINE       | <b>Art Unit</b><br>3625                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>16 August 2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The use of trademarks and trade names such as "IBM server," "iSeries," "AS/400," and the like, has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 1,3,4,13-15,21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1,4,13-15,21 and 23 contain the trademarks/trade names "IBM server," "IBM iSeries," "AS/400," and the like. Where a trademark or trade name is used in a

claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe various computer servers, systems, and components and, accordingly, the identification/description is indefinite.

Claim 3 refers to storing results "in a database on the e-commerce website." It is not understood precisely what applicant herein intends to claim. Is the database visible on a webpage? Is the database located at a URL? Is it publicly accessible or is it merely a storage location? Examiner does not intend to suggest that these answers are required in the claim, but rather is asking the questions in an effort to suggest to applicant how this subject matter might be better explained. Examiner has noted an over-reliance on the word "website" throughout the claims but has interpreted it wherever possible as a location and not necessarily a visible page.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**2. Claims 1-34 are rejected under 35 U.S.C. 102(a) as being anticipated by Creamer (US Pub.No. 2003/0233486 A1).**

Creamer teaches all the limitations of claims 1-34. For example, with regard to method claims 1-20 and 31-34, Creamer discloses receiving an XML formatted transaction, parsing the transaction, translating it into an intermediate protocol, dispatching it to a server, retrieving a handling program and executing the transaction.

Creamer further discloses:

- receiving an XML-formatted transaction: at a central e-commerce website (see at least abstract, figs.1-2, page 1 ¶0007, page 2 ¶0017, page 3 ¶0026, page 4 ¶0036, page 6 ¶0048);
- translating the XML-formatted transaction: into an intermediate XML transport protocol, converting the XML transactions into an intermediate protocol (see at least page 3 ¶0023, page 4 ¶0031, page 5 ¶0045, page 6 ¶0050);
- dispatching the transaction to a server: creating a data structure compatible with the server, loading contents of the transaction into the data structure, transmitting the transaction to and/or receiving the transaction at a proprietary computing system (see at least page 2 ¶¶0012,0018; page 3 ¶¶0023,0028; page 4 ¶¶0029-0031, page 5 ¶¶0041,0045. Please note: the owner or legal status of a

computing system is not patentable subject matter. This is interpreted as a computing system);

- parsing the transaction: at the server to determine a transaction type (see at least abstract, figs.1-2, page 2 ¶¶0012,0018; page 3 ¶¶0023,0028; page 4 ¶¶0029-0031, page 5 ¶¶0041,0045);
- retrieving a handler program and a customizable subroutine: on the server based upon the transaction type (see at least abstract, figs.1-2, page 1 ¶¶0004,0011; page 2 ¶¶0017-0018, page 4 ¶¶0029-0030,0032,0037); selecting the handler program and customizable subroutine from a routing table, querying a router table and retrieving a handler program from the router table using the transaction type (see at least page 2 ¶¶0019-0020, page 4 ¶¶0032-0033,0036);
- executing the transaction: on the server using the handler program and customizable subroutine, passing the data structure to the customizable subroutine for execution, executing or calling one or more local or external applications using data in the data structure, executing or calling a COBOL or RPG program using data in the data structure (see at least abstract, figs.1-2, page 1 ¶0007, page 2 ¶0017, page 3 ¶0025, page 6 ¶¶0049-0050. Please note:  
  
The programming language is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in

the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. It is also noted that a program per se is not patentable subject matter and a data structure per se is nonfunctional descriptive matter); processing the transaction according to one or more business rules (see at least page 1 ¶¶0005-0007, page 2 ¶0021); results of processing are stored in a database, storing results of execution in the data structure (see at least abstract, page 2 ¶¶0012, 0018-0019; page 3 ¶¶0026,0028; page 4 ¶0036, page 5 ¶0045); translating the results of execution stored in the data structure into one or more XML responses, dispatching the one or more XML responses to a transaction requester via the e-commerce website (see at least abstract, page 2 ¶0013, page 3 ¶¶0022-0023,0026,0028; page 4 ¶¶0035-0036, page 6 ¶¶0047,0050)

*Pertaining to system claims 21-30*

Rejection of claims 21-30 is based on the same rationale as noted above.

Creamer also discloses:

- a server in communication with the e-commerce website: (see at least page 2 ¶¶0012,0018-0019; page 3 ¶¶0023-0024,0028; page 4 ¶¶0030-0032).

### ***Conclusion***

The examiner cites particular pages and paragraphs or columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Meltzer, US Patent No. 6,125,391 (Sept. 2000): Teaches routing machine readable transaction documents such as XML based documents through a central marketing site that parses the documents, translates, and executes them, and then forwards them to the appropriate parties.
- Bray, US Pub. No. 2002/0099633 A1 (July 25, 2002): Teaches managing communication of information through software and a client-server architecture. Discloses receipt of information in file form via file transfer service, conversion and translation of information into intermediate format, processing of information in intermediate format, and then translation into a preferred format for transmission to requesting destination.



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- Ogawa, US Patent No. 5,608,874 (March 4, 1997): Teaches receipt of data at intermediate location, identifying format, translation into common format, transmission of data in intermediate format and then translating into preferred format of recipient. Selects and implements specific modules.
- Fletcher-MacDonald, "TEST CENTER COMPARISON. (online procurement; Trilogy Software's Buying Chain, Version 2.0 software; Agentic's SupplyChannel, Version 1.3.3 and Works.com services) (Company Business and Marketing)," July 19, 1999; InfoWorld , v 21 , n 29: Teaches web based procurement, receipt of transaction data at server, translation into XML, parsing of transaction and execution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
Patent Examiner  
March 16, 2008

/Yogesh C Garg/

Primary Examiner, Art Unit 3625